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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,399	07/03/2003	Louis Brown Abrams	4811-18	5901
22442	7590	01/10/2007		
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/614,399

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27,29-47 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27,29-47 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed October 24, 2006, has been entered. Claims 27, 29, 30, 35, 46, and 49 have been amended as requested. Claims 1-26, 28, and 48 are cancelled, while new claims 50 and 51 have been added. Thus, the pending claims are 27, 29-47, and 49-51.
2. Said amendment is sufficient to withdraw the claim objections set forth in sections 6 and 7 of the last Office Action. Additionally, said amendment is sufficient to overcome the 112, 1<sup>st</sup> and 2<sup>nd</sup> rejections set forth in sections 8-12 of the last Office Action.

### ***Information Disclosure Statement***

3. The information disclosure statement filed September 14, 2006, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the two French references and the Japanese reference have not been considered.

### ***Double Patenting***

4. Claims 27, 29-47, and 49-51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-11 and 27-41 of

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copending Application No. 10/614,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap or are obvious variants thereof. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Applicant's willingness to file a Terminal Disclaimer upon indication of allowable subject matter is acknowledged (Amendment, page 6, 1<sup>st</sup> paragraph).

#### ***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 27, 29-47, and 49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-058824 issued to Kondo et al. in view of JP 58-062027 issued to Moriyama et al., US 4,810,549 issued to Abrams et al., and US 6,646,022 issued to Okazaki et al. as set forth in section 15 of the last Office Action.

#### ***Response to Arguments***

8. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

9. Applicant traverses the above rejection by asserting that Kondo fails to teach or suggest certain features of the present claims (Amendment, page 7, 2<sup>nd</sup> paragraph). The examiner agrees. Accordingly, the rejection of the claims is not based upon Kondo alone, but rather is based upon Kondo in view of Moriyama. One cannot show nonobviousness by attacking references

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individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. Regarding Kondo's lack of a teaching of a decorative flock layer, as noted in the prior Office Action, it would have been readily obvious to substitute a decorative flock layer, as taught by Moriyama, for the decorative layer of Kondo since Moriyama establishes that flock layers are suitable decorative layers for molded articles. Regarding the use of a thermosetting adhesive as the adhesive layer bonding the flock to the backing film, it was previously argued that it would have been readily obvious to one of ordinary skill in the art to select a thermosetting adhesive for the adhesive of Kondo. Motivation to do so would be to produce a very secure bond between the decorative flock material and the backing material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

11. Applicant traverses the rejection over Kondo in view of Moriyama by asserting that Moriyama fails to teach or suggest solving the problem of insufficient adhesion between an adhesive and the resin through the use of a polymeric backing material (Amendment, page 8, 1<sup>st</sup> paragraph). In response, it is argued that Moriyama need not teach this feature. Moriyama is only relied upon for its teaching that flock is a suitable decorative layer for molded articles. The use of polymeric backing layer between an adhesive layer and the molded resin is clearly taught by Kondo.

12. Regarding the examiner's obviousness rejection of the selection a thermoset adhesive, applicant argues that Kondo fails to teach that "a thermoplastic adhesive will fail to work with

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flock because the adhesive will soften during molding, causing the flock to become disoriented and the “feel” and appearance of the article to be marred” (Amendment, page 9, 1<sup>st</sup> paragraph). Without such a teaching as to the problem of using thermoplastic adhesives with the flocked molded article, applicant feels “one of ordinary skill in the art would have no reason to select a thermosetting adhesive over a thermoplastic adhesive” (Amendment, page 9, 1<sup>st</sup> paragraph). In response, it is agreed that Kondo includes no such teaching because Kondo does not even teach flocked articles. Additionally, applicant’s assertion that thermoplastic adhesives will “fail” is not necessarily accurate. Thermoplastic adhesives are suited for decorative molded articles as long as the melting temperature of said adhesive is above the temperature of the mold. Furthermore, as previously argued, one of ordinary skill in the art readily understands the differences between and advantages of thermoplastic and thermoset adhesives. As such, one would readily be able to select an appropriate adhesive for the molding process of Kondo.

13. In response to applicant’s argument that the examiner’s conclusion of obviousness is based upon improper hindsight reasoning (Amendment, page 9, 1<sup>st</sup> paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The present rejection is based upon the knowledge disclosed within the cited references and that which is readily known in the art, rather than gleaned from applicant’s own disclosure.

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14. Applicant traverses the rejection over Kondo and Moriyama in further view of Abrams '549 and Okazaki by asserting that both references fail to address the deficiencies of Kondo and Moriyama (Amendment, page 9, 2<sup>nd</sup> paragraph – paragraph spanning pages 10-11). Since the teachings of Kondo and Moriyama have not been found deficient for the reasons set forth above, applicant's arguments are found unpersuasive and the above rejections are maintained.

***New Claim Rejections - 35 USC § 103***

15. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Kondo reference in view of the cited Moriyama, Abrams, and Okazaki references as applied to claim 27 above.

Claim 50 is rejected for reasons analogous to those presented in the rejection of claim 46 since the limitation of claim 50 is similar to that of claim 46. In other words, the backing film taught by Kondo and Moriyama is a *film* and not a textile or fabric. Therefore, claim 50 is rejected.

Regarding claim 51, it would have been readily obvious to one skilled in the art to employ a backing film resin and mold resin which differ in chemical composition. While the polymers of the molded resin and the backing layer may be the same in Kondo, it would have been readily obvious to vary the overall compositions with auxiliary ingredients. Motivation to do so would be to facilitate the varying process conditions required for each layer. Employing the same polymer enables chemical and physical compatibility between the two resins producing a strong bond therebetween. However, since said resins are subjected to different processing conditions (e.g., film formation vs. molding), it would be necessary to vary the amount of filler

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or auxiliary chemicals to facilitate said different processing conditions. Upon the addition of said various auxiliary components, the resins would inherently possess different chemical compositions (e.g., different melting and softening points). Hence, claim 51 is rejected.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

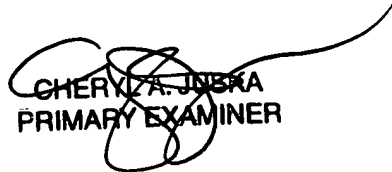
17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JONES  
PRIMARY EXAMINER

cj

January 1, 2007